

REMARKS/ARGUMENTS

Prior to this amendment, claims 2-17, 26-29 and 31-36 were pending. In this amendment, claims 10 and 12-15 are amended. No claims are canceled or added. No new matter is added. Thus, after entry of this amendment, claims 2-17, 26-29 and 31-36 remain pending.

Allowed Claims

Applicants note with appreciation the Examiner's indicated allowability of claims 2-9 and 26-28.

Claim Rejections – 35 USC 101, Non-Statutory Subject Matter

Claims 29 and 31-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

At pages 2 and 5, the Office Action asserts that a useful, concrete, tangible result is always required of a claimed process if an article or physical object is not transformed. However, this is an incorrect statement of the law after Bilski.

The Office Action also states that being tied to a particular apparatus does not provide a tangible result, which contradicts MPEP 2106 IV.C.2.(2).b).

At page 20 of Bilski (2007-1130), the Federal Circuit states:

we also conclude that the "useful, concrete and tangible result" inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court is the proper test to apply.

Regarding the machine-or-transformation test, the Federal Circuit further stated:

A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Accordingly, the present state of the law does not require a useful, tangible, concrete result in addition to a claimed process being tied to a particular machine.

In fact, this has never been the state of the law. MPEP 2106 IV.C.2.(2).b) states:

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.

By this statement, if a claim is tied to a particular machine, then a “tangible result” is achieved.

Given that at page 5 the Office Action concedes that claim 29 is tied to a particular apparatus, claim 29 is directed to patentable subject matter.

Furthermore, if the Examiner asserts that the claimed invention preempts a judicial exception, then Applicants request an identification of the abstract idea, law of nature, or natural phenomenon and why the claim covers every substantial practical application thereof. Specifically, MPEP 2106 IV.C.2 states:

If USPTO personnel determine that the claimed invention preempts a 35 U.S.C. 101 judicial exception, they must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof.

Applicants submit that not every substantial application for the multiplication of three binary numbers is covered by claim 29. For example, not every application uses a look-up table (LUT) or has a multiplexer that receives a carry from a first LUT, as recited in claim 29.

For at least these reasons, Applicants submit that claim 29 and its dependent claims are directed to patentable subject matter.

Claim Rejections - 35 USC § 102(b), Rothman

Claims 10-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rothman et al. (5,898,602).

Claim 10 is allowable as Rothman does not teach or suggest each and every element of claim 10. For example, claim 10 recites “*wherein the signal determined in the LE is dependent on at least one bit input into the LE on a same input line as one of the three binary numbers.*”

At page 3, the Office Action asserts that the AND gate that receives a carry signal (e.g. C_0, C_1) is the claimed multiplexer, which selects C_1 from the previous LE when the LE is set to operate in an addition of three numbers. Assuming *arguendo* that this assertion is true, the input signal determined in the present LE is the arithmetic carry control. *See Rothman, FIG. 3.*

The arithmetic carry control signal would be set to “0” for all of the ALUs when a carry function is not to be performed and set to “1” when a carry function is to be performed. Thus, the arithmetic carry control signal is not dependent on any input bits into an ALU, but is programmed to be a constant for all of the ALUs. Furthermore, the arithmetic carry control signal is not dependent on any bit input on lines A_1 , B_1 , or C_1 .

Accordingly, Rothman does not teach or suggest “*wherein the signal determined in the LE is dependent on at least one bit input into the LE on a same input line as one of the three binary numbers*,” as recited in claim 10.

For at least these reasons, claim 10 and its dependent claims are allowable over Rothman.

Claim Rejections - 35 USC § 102(b), Cohen

Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cohen et al. (5,511,017).

Claim 10 is allowable as Cohen does not teach or suggest each and every element of claim 10. For example, claim 10 recites “*wherein the multiplexer selects the signal determined in the LE when the LE is not set to operate in an addition of three binary numbers mode.*”

At page 4, the Office Action states that the Adder 35 always performs an addition of three binary numbers. Thus, the signal from element 17 is also selected when the asserted LE performs an addition of three binary numbers. Thus, Cohen does not teach selecting the signal from element 17 when the asserted LE is not performing an addition of three binary numbers. In fact, the asserted LE is never set to not operate in an addition of three binary numbers.

Accordingly, Cohen does not teach or suggest the above claim element.

For at least these reasons, claim 10 and its dependent claims are allowable over Cohen.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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